



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,215	12/21/2001	Steward D. Elsegood	BOSSCOM.003AUS	3460

20995 7590 05/20/2003

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
----------	--------------

1723

6

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,215

Applicant(s)

ELSEGOOD, STEWARD D.

Examiner

Matthew O Savage

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4, 5. 6) ☐ Other: _____

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Vogrin.

With respect to claim 1, Vogrin discloses an adapter body 11 including an upper perforated portion and a lower perforated portion (see the perforations 24 and 25 in FIGS. 1 and 3), a centrally located opening (e.g., receiving part 13, see FIGS. 2 and 3) passing through the upper and lower portions, a hollow insert 13 (see FIG. 2) mounted inside the opening and providing a first threaded portion adapted to engage a threaded stud and a second threaded portion adapted to mount to a filter, and a magnet 17 disposed within the adapter body for removing metallic particles from the fluid.

Concerning claim 2, Vogrin discloses the magnet as being in the shape of a ring (see FIGS. 1 and 3).

As to claim 3, Vogrin discloses a ring support (e.g., the sleeve surrounding part 13 shown in FIG. 3) for mounting the magnet to the adapter body such that a gap exists between the magnet and upper portion.

Regarding claim, 4, Vogrin discloses the upper portion as including a sealing gasket 22 (see FIG. 1).

Concerning claim 5, Vogrin discloses the perforated upper portion as including a circular pattern of perforations 24.

As to claim 6, Vogrin discloses the lower portion as including a circular pattern of perforations 25.

Claims 7-9 relate to intended use and carry no patentable weight since the fluid is not considered part of the apparatus.

With respect to claims 10 and 11, Vogrin discloses a cylindrical adapter body 11 including an perforated upper portion and a perforated lower portion (see the perforations 24 and 25 in FIGS. 1 and 3), a centrally located opening (e.g., receiving part 13, see FIGS. 2 and 3) passing through the upper and lower portions, a hollow insert 13 (see FIG. 2) mounted inside the opening and providing a first connection means adapted to engage a connection means on a fluid source, the first connection means being an internally threaded portion of the hollow insert 13 that is equivalent to internally threaded portion 71 shown in FIG. 2 of the instant drawings, and a second threaded portion connection means adapted to mount to a filter, the second connection means being an externally threaded portion of the hollow insert 13 that is equivalent to externally threaded portion 238 shown in FIG. 2 of the instant drawings, and a magnet 17 disposed within the adapter body for removing metallic particles from the fluid.

Regarding claim, 12, Vogrin discloses the upper portion as including a sealing gasket 22 (see FIG. 1).

Concerning claim 13, as best understood, Vogrin discloses the perforated upper portion as including a circular pattern of perforations 24.

As to claim 14, as best understood, Vogrin discloses the lower portion as including a circular pattern of perforations 25.

Claim 15 relate to intended use and carry no patentable weight since the fluid is not considered part of the apparatus.

Concerning claim 16, Vogrin discloses the magnet as being in the shape of a ring (see FIGS. 1 and 3).

As to claim 17, Vogrin discloses a ring support (e.g., the sleeve surrounding part 13 shown in FIG. 3) for mounting the magnet to the adapter body such that a gap exists between the magnet and upper portion.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogrin in view of Fearnhead.

With respect to claim 19, Vogrin discloses inserting a magnet 17 (see FIGS. 1 and 3) in an adapter housing 11 having an upper perforated portion and a lower perforated portion, and inserting a hollow insert 13 in a centrally located opening passing through the upper portion, the lower portion, and the magnet. Vogrin, as best understood, fails to specify placing the magnet in the perforated lower portion followed by enclosing the magnet in the adapter by attaching a perforated upper portion of a housing to the perforated lower portion. Fearnhead discloses that its known to enclose a filter member within a housing by first placing the filter member in a lower portion 11 of

Art Unit: 1723

the housing followed by enclosing the filter member in the housing by attaching a perforated upper portion 13 to the lower portion, and suggests that such steps provide a strong and leak proof filter assembly. It would have been obvious to have modified the method suggested by Vogrin so as to have include the method of enclosing the filter member in a housing as suggested by Fearnhead in order to provide a strong and leak proof housing.

Concering claim 20, Vogrin discloses attaching a sealing gasket 22 to the upper portion (see FIG. 1).

Regarding claim 21, Vogrin discloses mounting a ring support and magnet in a housing (see the upper ring surrounding part 13 in FIG. 3). Vogrin fails to specify mounting the ring support to the magnet and then inserting the ring support along with the magnet into the lower portion, however, the change in the sequence of process steps is considered obvious absent any evidence of unexpected results since the magnet and ring support of Vogrin are capable of being mounted in such a manner.

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

It is suggested that claim 18 amended to specify the location of the spacer in relation to the magnet and adapter housing. It is further noted that the prior art fails to specify the magnet as being mounted by the spacers such that a gap exists between

Art Unit: 1723

the inner bore of the magnet and the outer surface of the hollow insert to permit fluid to circulate therebetween.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. Savage

Matthew O Savage
Primary Examiner
Art Unit 1723

mos
May 16, 2003